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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/762,642

01/20/2004

Mark Horton

30,800-00US

5319

7590

05/01/2006

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EXAMINER

PRONE, JASON D

ART UNIT

PAPER NUMBER

3724

DATE MAILED: 05/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/762,642

Applicant(s)

HORTON, MARK

Examiner

Jason Prone

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 12-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 12-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Appendix A dp 4-26-06

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 5 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Applicant's amendment to claim 1 now incorporates the limitation of claim 5.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1 and 5 are rejected under 35 U.S.C. 102(e) as being anticipated by McGuyer (D509,114). See Appendix A, at the end of this Office action for examiner added reference numerals.

McGuyer discloses the same invention including a cutting device having a cutting wheel (3), a handle (7) having a finger stop structure (5), a top surface adapted to engage a longitudinally extended index finger (55) and a neck portion coupled to the cutting wheel and arcuately extending from the first end of the handle (2), and the neck portion has a length greater than or equal to the diameter of the cutting wheel (2).

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4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claim 17-20 is rejected under 35 U.S.C. 102(b) as being anticipated by Arend et al. (6,044,565). In regards to claim 17, Arend et al. discloses the invention including providing a cutting device having a cutting wheel (6) and a handle (31), the handle having a length of between 4.5 and 7 inches (Column 3 lines 7-11), a finger stop (4), the handle having a first end and a top surface adapted to engage an index finger (Column 3 lines 24-48) grasping the handle of the cutting device with one end of the cutting device being held entirely within the palm of the user's hand (Column 3 lines 49-58 continued to Column 4 lines 1-4) and one surface of the handle engaging a substantial portion of the user's index finger (3), and a tip of the index finger engaging the finger stop (4) and rolling the cutting wheel across a flat food item to cut the item (Title and Abstract. Abstract states the cutter is for sheet goods. Sheet goods are capable of being food sheet goods.). In regards to claim 18-20, Arend et al. discloses the same method steps Column 3 lines 24-58).

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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7. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuyer in view of Stowell et al. (RE37,190). McGuyer discloses the invention including the finger stop is an elongate pad extending along a top surface of the handle (5).

However, McGuyer fails to disclose the finger stop is made of rubber.

Stowell et al. teaches the finger stop is made of rubber (18A). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided Larson with a stop made from rubber, as taught by Stowell et al., to prevent the user's hand from slipping while in use.

8. Claims 4 and 6-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuyer in view of Arend et al. McGuyer discloses the invention however, McGuyer remains silent on the specific dimensions of the cutting apparatus and what it is formed of and, therefore, fails to disclose, the ratio of the length of the handle to a diameter of the wheel is approximately 3 to 1, the length of the handle is approximately 6 inches, the diameter of the cutting wheel is approximately 2 to 3 inches, and the handle is formed of plastic.

It is noted that the term "approximate" means very similar (The American Heritage®

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Company. All rights reserved). In light of this definition, Arend et al. teaches, in regards to claim

4, the ratio of the length of the handle to a diameter of the wheel is approximately 3 to 1

(6.25 and 1.75 is approximately a 3 to 1 ratio, Column 3 lines 7-23). In regards to

claims 6-8, Arend et al. teaches the length of the handle is approximately 6 inches

(Column 3 line 10, 6.25 inches is approximately 6 inches). In regards to claim 9, Arend

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et al. teaches the diameter of the cutting wheel is approximately 2 to 3 inches (Column 3 line 13, 1.75 inches is approximately 2 inches). In regards to claim 10, Arend teaches the handle is formed of plastic (Column 4 lines 5-10). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided McGuyer with specific dimensions/ratios/materials, as taught by Arend et al., to allow the apparatus to best conform to an average user's hand.

9. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuyer in view of Riley (5,491,898). McGuyer discloses the invention including, in regards to claim 12, a cutting wheel (3), a handle made of a first material (7) and having a top surface along a first end adapted to engage a longitudinally extended index finger (55), a finger stop structure connected to the top surface along the first end and positioned to confront the tip of the index finger (5), the finger stop structure made from a slip-resistant material (5), a neck extending arcuately from the first end of the handle (2), and the length of the neck is greater than the diameter of the cutting wheel (2). In regards to claim 13, McGuyer discloses the finger stop structure includes an elongate pad made of slip-resistant material (5).

However, McGuyer fails to disclose the finger stop is made of a second material Riley teaches adding a second non-slip material to a portion of a handle designed to encounter the fingers of the user (Column 4 lines 54-57). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided McGuyer with a stop made from a second non-slip material, as taught by Riley, to prevent the user's hand from slipping while in use.

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10. Claims 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over McGuyer in view of Riley as applied to claim 12 above, and further in view of Arend et al. McGuyer and Riley disclose the invention however, McGuyer and Riley remain silent on the specific dimensions of the cutting apparatus and, therefore, fails to disclose, the ratio of the length of the handle to a diameter of the wheel is approximately 3 to 1 and the diameter of the cutting wheel is approximately 2 to 3 inches.

It is noted that the term "approximate" means very similar (The American Heritage® Dictionary of the English Language, Fourth Edition, Copyright © 2000 by Houghton Mifflin Company. Published by Houghton Mifflin Company. All rights reserved). In light of this definition, Arend et al. teaches, in regards to claim 15, the ratio of the length of the handle to a diameter of the wheel is approximately 3 to 1 (6.25 and 1.75 is approximately a 3 to 1 ratio, Column 3 lines 7-23). In regards to claim 14 and 16, Arend et al. teaches the diameter of the cutting wheel is approximately 2 to 3 inches (Column 3 line 13, 1.75 inches is approximately 2 inches). Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have provided McGuyer in view of Riley with specific dimensions/ratios, as taught by Arend et al., to allow the apparatus to best conform to an average user's hand.

#### ***Response to Arguments***

11. Applicant's arguments with respect to claims 1-10 and 12-20 have been considered but are moot in view of the new ground(s) of rejection. In response to applicant's argument that cutters used in the previous rejection and the cutter used in the current rejection do not teach a top surface supporting an index finger, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the

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claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. All the cutters used in the rejections are capable of supporting an index finger on the top surface regardless if the reference teaches using a thumb on the top surface. The cutter of the instant application is also capable of supporting a thumb on the top surface.

### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Webb and Lee.

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.



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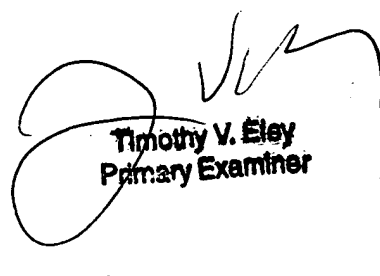
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Prone whose telephone number is (571) 272-4513. The examiner can normally be reached on 7:30-5:00, Mon - (every other) Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on (571) 272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

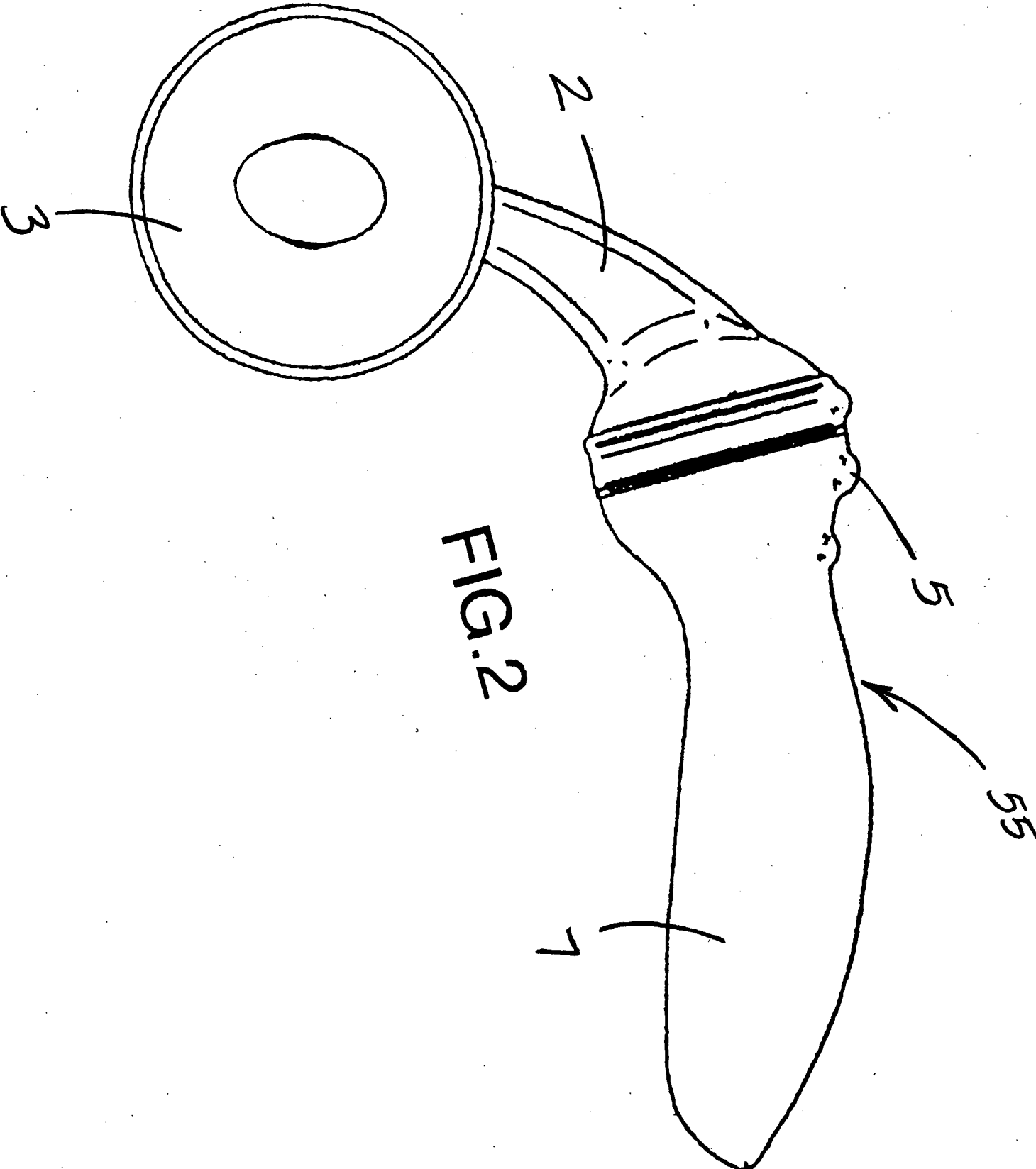


JP  
April 26, 2006



Timothy V. Eley  
Primary Examiner

Appendix A



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